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IN THE

**Supreme Court of the United States**

**October Term, 1946**

**No. 768**

LINCOLN STORES, INC.,

*Petitioner,*

*vs.*

NASHUA MANUFACTURING COMPANY,

*Respondent.*

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**PETITION OF LINCOLN STORES, INC. FOR A WRIT  
OF CERTIORARI TO THE CIRCUIT COURT OF  
APPEALS FOR THE FIRST CIRCUIT, AND BRIEF  
IN SUPPORT THEREOF.**

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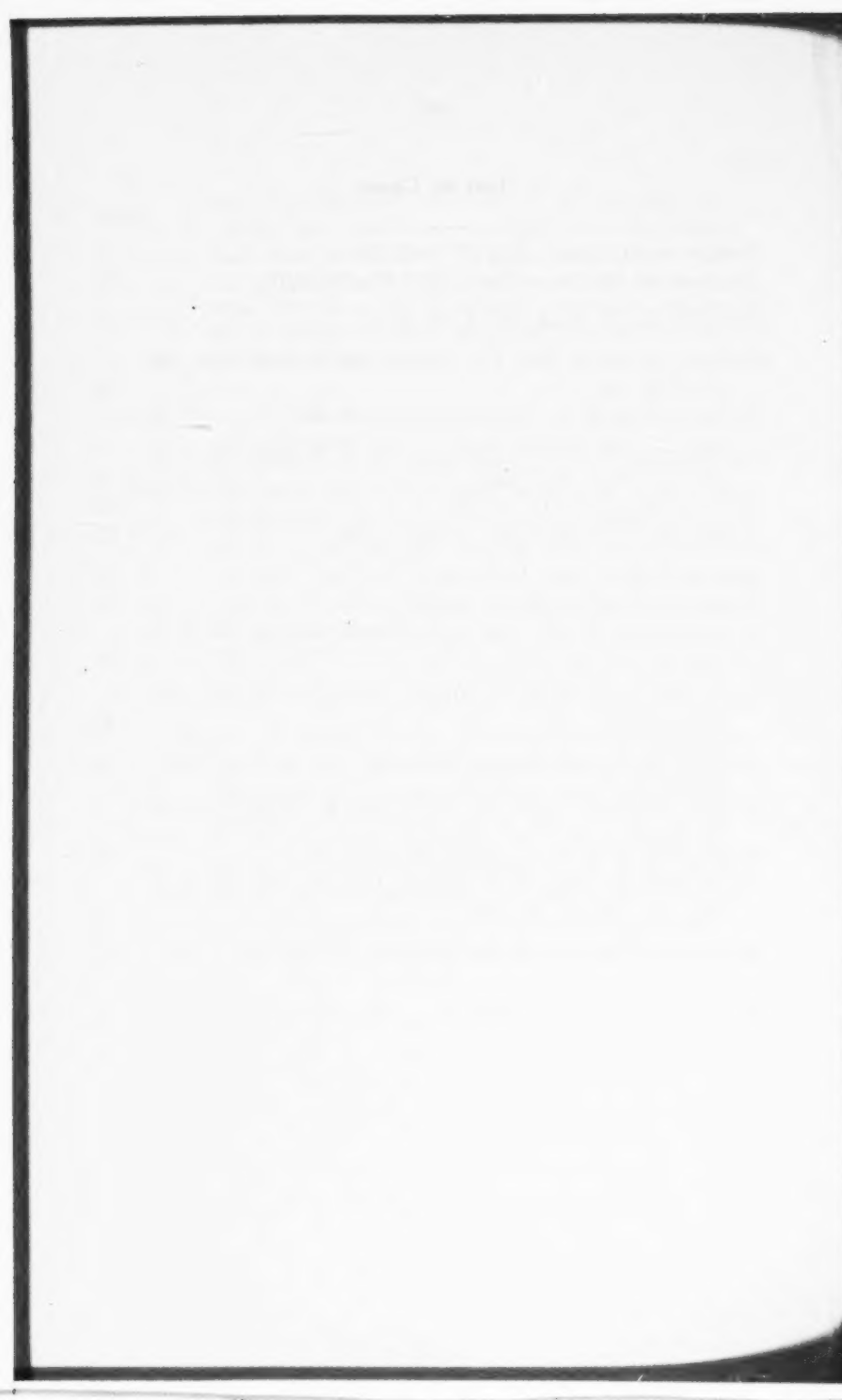
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## PETITION OF LINCOLN STORES, INC. FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

*To the Honorable, The Chief Justice and Associate Justices  
of the Supreme Court of the United States:*

Your petitioner, LINCOLN STORES, INC., respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the First Circuit to review the judgment of that Court entered on the 19th day of July 1946 (petition for rehearing denied October 7, 1946).

A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith in accordance with the rules of this Court.

### **Summary and Short Statement of the Matter Involved.**

1. Respondent, NASHUA MANUFACTURING COMPANY, a corporation of New Hampshire, is the owner of Amory Patent No. 2,208,533, granted July 16, 1940, for alleged invention in "Household Blanket".

2. Petitioner, LINCOLN STORES, INC., a corporation of Massachusetts, operates stores for retail sale to the purchasing public of various commodities, specifically including household blankets which it purchases from blanket manufacturers. The sale by Petitioner, at its store at Waltham, Massachusetts, of a blanket purchased from Marshall Field & Company, was charged by the complaint in this cause as an act of infringement of Respondent's patent. Marshall Field & Company openly defended the case.

3. Practically since the beginning of the blanket industry wool has been regarded as the most desirable material from which to weave blankets. This has been because of the inherent warmth and durability of wool fibers, as well as their susceptibility to treatment, *e. g.* "napping" (mechanically pulling some of the fibers into a substantially upright position), to give the surface of the blankets a soft feeling and a pleasing appearance and improve its insulating qualities. However, wool was notoriously far more expensive than other available fibers, so that for many years it had been the practice to mix fibers of other material with the wool fibers in forming the yarn used to weave the blankets, in order to reduce the cost of blankets to the purchasing public. To this end it was customary to substitute for wool fibers as much fibers of other material as could be used without too greatly decreasing the warmth,



strength, and durability of the blanket, or too greatly affecting the pleasing feeling and appearance thereof.

4. Among the many non-wool fibers that were extensively used for many years for this purpose was the so-called artificial or synthetic fiber produced from rayon; and wool-rayon blankets were extensively marketed and were fully described in printed publications many years prior to the Amory invention.

5. These prior wool-rayon blankets were made in accordance with the same procedure and on the same weaving machines theretofore used in the fabrication of blankets; and the rayon fibers employed were of *varying* short lengths, as distinguished from *uniform* short lengths.

6. The invention found for the Amory patent in suit, by which it is purported to distinguish from the prior art, is the use of "staple" rayon fiber mixed with wool fiber, woven in accordance with the same processes and on the same machines as theretofore used; and the Courts below interpreted the term "staple" to mean "fibers of a predetermined *uniform* length" (R. 411).\*

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\* Factually, the Armory patent gives no definition of the term "staple", and the specifications of the patent negate the Courts' definition thereof because not only are the claims in suit silent as to the fiber *length*, but the only instruction contained in the specification with respect thereto is that found in column 2, page 1, line 45 of the patent (R. 265) that—

"\* \* \* the filling wrapping should include a *substantial proportion* of fibers of a length of  $1\frac{1}{2}'' \pm \frac{1}{2}''$  in order to secure an adequate number of ends to provide the desired nap of the invention".

This means that the fibers could be from one to two inches long—a variation of 100%. And there is no information whatever as to what constitutes a "*substantial proportion*" of the short length fibers (Cf. *General Electric v. Wabash*, 304 U. S. 364; *Halliburton Oil Well Cementing Co. v. Walker*, Case No. 24, decided Nov. 18, 1946). Thus it is evident that the patent is fatally indefinite at the exact point of alleged novelty thereof.

7. Therefore, the only novelty found for the Amory patent is the use of rayon fibers of *uniform* short length in the same manner and for the same purpose that rayon fibers of *non-uniform* short length theretofore had been used.

8. The District Court concluded that this constituted "invention", and with obvious uncertainty as to whether or not such conclusion constituted a *finding of fact* or a *conclusion of law*, the District Court made both a finding and a conclusion with respect thereto (Finding 26, Conclusion 2, R. 40).

9. The affirming majority opinion of the Court of Appeals expressly stated its uncertainty (because of the many conflicting opinions thereon) as to whether the question of "invention" is one of *fact* or of *law* (R. 422), and with an implied doubt as to the soundness of considering the question as one of *fact*, stated (R. 422) that "*Until advised to the contrary by the Supreme Court*" it would treat the question as one of *fact*, and therefore it was "*impossible*" for the Court to reach a conclusion differing from that of the District Court because of the exacting requirement of Rule 52(a) of the Federal Rules of Civil Procedure.

10. On the other hand, the dissenting opinion of Judge WOODBURY, while also implying the same uncertainty on this question, reached the conclusion that even if "invention" is a question of *fact*, and found as a fact by the District Court to be present in the Amory patent, nevertheless, controlling propositions of *law* must thereafter be considered and applied if applicable; and that the present case was controlled by the rule of law, established in 1850 by this Court, that no *patentable* invention was involved in the mere substitution of one known material for another, where-  
*by the only asserted difference is one of degree, as dis-*

tinguished from one of *species or kind*. Judge WOODBURY stated (R. 424):

"Thus I conclude, as my associates do, that Amory's contribution consisted in the substitution of one known material for another in an old combination. My disagreement in this case stems from my inability under these circumstances to reconcile the finding of invention made below with the rule of law enunciated by the Supreme Court in 1850 in the case of *Hotchkiss v. Greenwood*, 11 How. 248, since in my view Amory's substitution of materials did not produce a rayon blanket different in kind or species from those which had preceded it (*Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, decided in 1876, see also our opinion on rehearing in *Grand Paper Box Co. v. Russell Box Co.*, decided April 17, 1946); but only produced a better rayon blanket than had previously been known.

• • • • •

"Hence I conclude that Amory's substitution of materials produced a rayon blanket differing from earlier ones in degree of excellence only—that Amory's substitution only accentuated desirable qualities possessed to less degree by the rayon blankets of the prior art—and thus that his patent is invalid under the rule of *Hotchkiss v. Greenwood*, *supra*." \*

11. Thus, by an unrealistic and strict application of a *procedural* rule, made applicable solely because of expressed doubt as to a *rule of law*, a decision has been rendered by the majority of the Court below which ignores the *law* applicable to the facts of the case as established by decision of this Court long prior to the adoption of the Federal Rules of Civil Procedure, which *law* the Federal Rules of Procedure, neither by language nor inference, purported to disturb.

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\* Emphasis ours throughout this Petition and Brief.

12. The adoption by the Court of Appeals of a definition of the term "staple" as used in the claims of the Amory patent, which definition is not contained in the patent itself, necessarily has rendered the claims vague and indefinite and violative of Section 4888 of the Revised Statute (35 U. S. C. 33) in that the claims require, at the precise point of novelty, a yarn composed "*essentially* of randomly intermingled staple artificial fibers". As pointed out in the footnote on page 3 hereof, the only information contained in the patent specifications as to fiber length is that there should be "a substantial proportion" of fibers of from 1" to 2" in length. It is inevitable that the *non-uniform*, short rayon fibers of the art prior to the patent included *some* fibers—and undoubtedly a very great many—of a length between 1" and 2". Therefore, in order to determine the limit of the monopoly of the patent claims as construed by the opinion of the Court of Appeals, and ascertain what is outside of the claim and in the public realm free for use by anyone, it is necessary to determine *how many* fibers of length of from 1" to 2" are necessary in order to have a yarn composed "*essentially*" thereof; or to constitute "*a substantial proportion*" of the fibers present in the yarn. *The Amory patent is entirely devoid of any statement, information or instruction on the subject.*

13. Practically, and as a matter of fact, the length of the rayon fiber (within much wider limits than here is pertinent) is quite immaterial because, when the blanket is "napped" to form the "lofty, homogeneous nap throughout the area and napped thickness of the blanket on both sides thereof" as recited in the claims, it is inevitable that the fibers are so cut and broken up as to make absolutely indistinguishable a blanket made from *uniform* rayon fibers from a blanket made from *non-uniform* fibers (R. 244, 254, 255).

14. In consequence, an unwarranted patent monopoly thus has been established which dominates and materially affects the health and comfort of the public, and particularly that portion of the public which depends upon the use of wool-rayon blankets for health and comfort because of their cheapness, as compared with blankets of other types.

### **Reasons Relied Upon for the Grant of a Writ of Certiorari.**

The discretionary power of this Court is invoked upon the following grounds:

1. Because the Court of Appeals for the First Circuit, in both the majority and minority opinions, has virtually invited this Court to finally settle a proposition of patent law as to which the authorities—including the decisions of this Court—are in irreconcilable conflict.

2. Because the majority opinion of the Court of Appeals has sustained a patent as valid upon doubtful acceptance of a *procedural rule* as paramount to an otherwise controlling *rule of law* established by this Court as early as 1850, and consistently applied by this Court as well as by the lower Courts since that date.

3. Because the Court of Appeals, in effect, has sustained as valid a patent which has been interpreted to differ from what preceded it only in *degree* and not in *species or kind*, and therefore has rendered a decision which is in direct conflict with the applicable decisions of this Court.

4. Because the Court of Appeals has sustained as valid patent claims that fail to make the "full, clear, concise and exact" description of the alleged invention required by Section 4888 of the Revised Statutes (35 U. S. C. 33), as that

Statute was interpreted by this Court in *General Electric v. Wabash*, 304 U. S. 364; *United Carbon Co. et al. v. Binney & Smith Co.*, 317 U. S. 218; and *Halliburton Oil Well Cementing Co. v. Walker*, Case 24, decided November 18, 1946.

5. Because in rendering its majority opinion, the Court of Appeals has completely ignored the public interest, and has made possible the subjecting of the poorer members of the purchasing public to the necessity of paying patent tribute in order to acquire inexpensive wool-rayon blankets regarded by them as desirable or necessary for their health and comfort.

WHEREFORE your petitioner respectfully prays that a writ of certiorari issue out of and under the seal of this Court, directed to the United States Court of Appeals, for the First Judicial Circuit, commanding said Court to certify and send to this Court, on a date to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court as to the questions herein presented, and that the judgment of the Court of Appeals be reversed insofar as it has sustained claims 7 and 16 of Armory Patent No. 2,208,533; and that petitioner may be granted such other and further relief as may seem proper.

Respectfully submitted,

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## **BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.**

### **Opinions of the Courts Below.**

The District Court filed no opinion, but on June 22, 1945 entered Findings of Fact and Conclusions of Law (R. 31), which were augmented by additional Findings and Conclusions on August 7, 1945 (R. 41).

The opinion of the Court of Appeals for the First Circuit is reported in 157 F. (2d) at page 154; and will also be found beginning at page 407 of the record.

### **Jurisdiction.**

The grounds for jurisdiction are:

1. The date of the judgment to be reviewed is July 19, 1946. Petition for rehearing was denied October 7, 1946.

2. The judgment was rendered in a civil action brought under the patent statutes to determine the issues of validity and infringement of Letters Patent of invention.

3. The statute under which jurisdiction is invoked is 240(a) of the Judicial Code, 28 U. S. C. A. 347, as amended by the Act of February 13, 1925.

4. Two of the many cases believed to sustain the jurisdiction are *United States Industrial Chemicals v. Carbide & Carbon Chemicals Corp.*, 315 U. S. 663, and *Halliburton Oil Well Cementing Co. v. Walker*, Case No. 24, decided November 18, 1946.

### **Statement.**

The facts are sufficiently stated in the petition.

### **Specification of Errors.**

The errors which petitioner will urge if the petition for certiorari is granted are that the Circuit Court of Appeals for the First Circuit erred:

1. in sustaining claims 7 and 16 of Amory Patent No. 2,208,533 as valid and infringed.

2. in holding, in effect, that the substitution of one material for another whereby there is obtained a mere difference in degree, as distinguished from a difference in species or kind, constitutes a patentable invention.

3. in holding that the Amory patent, as interpreted by the Court, complied with R. S. 4888.

4. in holding, in effect, that invention is a question of *fact* as distinguished from a question of *law*, whereby the provision of Rule 52(a) of the Federal Rules of Civil Procedure is paramount to and takes precedence over all other considerations and legal principles.

5. in failing to reverse the judgment of the District Court, and direct the dismissal of the complaint.

### **Summary of Argument.**

The points of argument follow the reasons relied upon for the grant of a writ of certiorari, and are stated on pages 7 and 8 of the petition, as well as in the index hereto. For the sake of brevity they are omitted at this point.



## POINT I.

**The Court of Appeals, in both its majority and minority opinions, has virtually invited this Court to finally settle a proposition of patent law as to which the authorities—including the decisions of this Court—are in irreconcilable conflict.**

Whether or not "invention" is disclosed in a patent grant is either a question of *fact* or a question of *law*. If it is a question of *fact*, then, according to the provision of Rule 52(a) of the Federal Rules of Civil Procedure, the finding of that *fact* by a District Court, "shall not be set aside unless clearly erroneous". Many of the Courts of Appeals have construed this rule as meaning that a *finding of fact* by a District Court may not be considered to be "clearly erroneous" if there is "substantial evidence" in the record supporting the District Court's finding.\*

Thus, in the present case, and regardless of what individually and independently each may have thought on the subject, the Judges constituting the majority of the Court of Appeals below believed themselves to be *foreclosed* by the finding of fact by the District Court that the Amory patent disclosed "invention".

However, the majority opinion expressly stated (R. 422):

*"Whether the question of invention is one of fact or of law is not too clear on the authorities; this uncertainty is indeed not entirely dispelled by consideration of decisions of the Supreme Court."*

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\* See, for example, *Corbett v. Halliwell*, 123 F. (2d) 331, C. C. A. 2; *U. S. v. Protsch*, 137 F. (2d) 92, C. C. A. 2; *Continental Oil Co. v. Jones*, 113 F. (2) 557, C. C. A. 10.

Thereupon, after reviewing two comparatively recent decisions of this Court in which this question was not specifically an issue before the Court, the majority opinion continues:

*"Until advised to the contrary by the Supreme Court we shall so regard it"* (as a question of fact). (Explanatory matter in parentheses ours.)

Similarly, Judge WOODBURY, writing the minority opinion of the Court, stated (R. 424):

*"I am willing to agree with my associates in regarding the question of invention as one of fact until advised to the contrary by the Supreme Court."*

Thereupon, he made reference to many authorities, including the decision of this Court in *Mahn v. Harwood*, 112 U. S. 354, 358, for the proposition that the presence or absence of "invention" is a question of *law*.\*

Even the District Court in the present case expressed doubt on the question by both finding as a *fact* and concluding as a matter of *law* that claim 7 of the patent discloses invention (Finding 26, Conclusion 2, R. 40).

Of course, all members of the Court of Appeals below were keenly alive to the impact of this question on judicial determination in patent litigation. Indeed, Judge WOODBURY in his minority opinion pointed out tersely and effec-

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\* Indeed, this Court repeatedly has held that in a patent suit before a jury if, upon the state of the art as shown to exist by prior patents, it appears that the claims are not novel, as a matter of *law* a directed verdict for the defendant should be ordered by the Court. Of course, this could be done only because the question of "invention" is one of *law*. *Heald v. Rice*, 104 U. S. 737; *Fond du Lac v. May*, 137 U. S. 395; *May v. Juneau*, 137 U. S. 408; *Market v. Rowley*, 155 U. S. 621. To the same effect are countless decisions of the lower Courts. For example, see *Prepayment Car Sales v. Orange County Traction Co.*, 221 F. 939, C. C. A. 2.

tively one consequence of the acceptance of "invention" as a finding of *fact* in the sense and to the extent adopted by the majority opinion.

We interpret the foregoing statements in both of the opinions of the Court below not only as an invitation to this Court, but also as a *request* to this Court to review this case on this sharply defined and immeasurably important question; and we believe that this invitation, so requested by the entire Court below, was prompted by the awareness of that Court of the importance of specific consideration of this question, and decision thereon by this Court, to existing and future patent controversies.

It is submitted that the petition should be granted on this ground.

## POINT II.

**The majority opinion of the Court of Appeals has sustained a patent as valid upon doubtful acceptance of a *procedural* rule as paramount to an otherwise controlling *rule of law* established by this Court as early as 1850 and consistently applied by the lower courts since that date.**

As stated in connection with the foregoing Point I, the majority of the Court below apparently believed that application of the provision of Rule 52(a) of the Federal Rules of Civil Procedure required acceptance by it of the District Court's finding of fact that the contribution to the arts by Amory, the patentee, constituted an "invention". As a result—and this also was tersely and most effectively pointed out in the dissenting opinion of Judge WOODBURY—the majority of the Court believed that it was thereby pre-

cluded from consideration of any other legal principles which might be applicable.\* Therefore, the Court believed that the finding of fact was conclusive upon it because it was "impossible" for the majority of the Court "to say that the District Court was clearly erroneous in deciding that Amory had produced a patentable invention" (R. 422). However, *on the facts as agreed to by both the majority and minority opinions*, it is quite obvious that regardless of *any* finding of fact that may have been made by the District Court, a *rule of law* was established by this Court as early as 1850 that a valid patent may not issue for an alleged invention consisting of the mere substitution of one material for another to accomplish a mere difference of *degree* as distinguished from a difference in *species or kind*.

Thus, as a matter of convenience utilizing the minority opinion for a terse statement of what was agreed to by all of the members of the Court, we find Judge WOODBURY's statement (R. 424):

"Furthermore, *I agree with my associates' analysis of Amory's contribution*. That is to say, seeing nothing new in the warp threads which he used, in the way those threads were woven with his filling threads, in a filling thread consisting of a hard twisted core wrapped with slack twisted and undrafted artificial fibers, or in his napping process, I conclude that Amory's contribution was the use as wrapping for his filling threads of a large proportion of relatively coarse artificial fibers a substantial portion of which were uniformly  $1\frac{1}{2}'' \pm \frac{1}{2}''$  long, i. e.,

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\* Compare the decision in *Galland-Henning Mfg. Co. v. Logemann Bros. Co.*, 142 F. (2d) 700 (C. C. A. 7th) in which the Court held (p. 702) that while the holding of *invention* by the lower Court was a finding of *fact*, the determination of whether such invention was *patentable* was a question of *law*. The majority opinion in the present case made no distinction between "invention" and "*patentable* invention".

staple rayon, a known material, whereas the prior art had used for that purpose artificial fibers of short but random lengths and denier, i. e., garnetted rayon, another known material. *Thus I conclude, as my associates do, that Amory's contribution consisted in the substitution of one known material for another in an old combination.* My disagreement in this case stems from my inability under these circumstances to reconcile the findings of invention made below with the rule of law enunciated by the Supreme Court in 1850 in the case of *Hotchkiss v. Greenwood*, 11 How. 248, since in my view Amory's substitution of materials did not produce a rayon blanket differing in kind or species from those which had preceded it, (*Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, decided in 1876, see also our opinion on rehearing in *Grant Paper Box Co. v. Russell Box Company*, decided April 17, 1946); but only produced a better rayon blanket than had previously been known."

From this it will be seen that all members of the Court of Appeals below are in accord on the fact that all that the patentee had done was to substitute one known material for another (*uniform* length rayon fibers for *non-uniform* length rayon fibers) to produce an old product differing from what preceded it solely in *degree* and not in *species or kind*; and that disagreement arose between the members of the Court over the simple proposition of whether or not the effect of Rule 52(a) of the Rules of Civil Procedure vitiated and made inapplicable the *rule of law* established by this Court as early as 1850 and universally applied since that date (see the authorities cited in Point III hereof).

If the majority opinion of the Court of Appeals is allowed to stand as a precedent, the consequences thereof to existing and future patent litigation may not be foretold with any degree of certainty. It is certain, however, that the consequences will be disastrous in their effect upon the

public welfare. For example, no longer will there be any distinction between mere *novelty* and *patentable invention*, which latter, alone, under the Patent Statutes, warrants a valid patent grant which creates a monopoly adverse to the public right. In addition—and this is of far greater importance—the decision of a District Judge in a patent case, merely by finding “invention” as a *fact*, will put exclusively in the hands of District Judges final decision on the publicly vital question of patent validity, and preclude appellate review by making it “impossible” for Appellate Courts to say that the District Court’s finding was “clearly erroneous”. Thus, in the future the public will be deprived of the protection which this Court and the Courts of Appeals in recent years so frequently have found necessary to be accorded to it, by invalidating patents, for want of disclosure of invention, which unwarrantedly and erroneously had been held to be valid by inferior Courts.

It is submitted, therefore, that the petition for a writ of certiorari should be granted on this ground.

### POINT III.

**The Court of Appeals, in effect, has sustained as valid a patent which differs from what preceded it only in degree and not in species or kind, and therefore has rendered a decision which is in direct conflict with the applicable decisions of this Court.**

It is believed that this point requires no further citation of authority than the two decisions of this Court cited by Judge WOODBURY in his minority opinion, namely, *Hotchkiss v. Greenwood*, 11 How. 248, and *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486. However, it is believed that this Court cannot fail but be impressed by the large

number of cases to this effect collected and cited as established and unquestionable law in *Walker on Patents, Deller Edition* (Section 29, p. 179), and the 1944 supplement thereto.

Therefore, it is believed that the present petition should be granted on this ground if for no other purpose than to prevent the nullification of a long established *rule of law* by a *rule of procedure* which was formulated merely to expedite and simplify *proceedings* in the lower courts.

#### POINT IV.

**The Court of Appeals has sustained as valid patent claims that fail to make a "full, clear, concise and exact" description of the alleged invention as required by Section 4888 R. S.**

Both of the claims sustained by the Court of Appeals (Nos. 7 and 16, R. 267, 268), define the yarn used in the fabrication of the blanket of the patent as "consisting essentially of randomly intermingled staple artificial fibers". Although the patent nowhere defines what is meant by the term "staple", the Court of Appeals defined this term as meaning "a filament cut to a predetermined length \* \* \* preferably 1" to 2" " (R. 411); and, as is made clear by the opinion of the Court, the provision of "staple" fibers, as thus defined, is the only point of novelty found by the Court by which the patent distinguishes from the prior art. Here is a vagueness and indefiniteness that is fatal to the validity of the claims.

Even if the Court's definition of the term "staple" is accepted, however, it at once becomes evident that the claims of the patent are still fatally vague and indefinite

at the exact point of novelty in that it is impossible to ascertain therefrom the limits of the monopoly purported to be established thereby—it is impossible to distinguish between what is purported to be monopolized and what is within the public realm free for use by anyone.

As above pointed out, both patent claims purport to monopolize a blanket formed of yarn consisting “essentially” of the “staple” fibers. *What proportion of the fibers present in the yarn must be of “staple” fibers so as to make the yarn consist “essentially” of such fibers?* Referring to the patent specification for enlightenment on this vital point, it is found that the only mention of the subject is contained in page 1, column 2, line 45 of the patent (R. 265) which states:

“The filling wrapping should include a *substantial proportion* of fibers of the length of  $1\frac{1}{2}'' \pm \frac{1}{2}''$ .”

Again the query is forced: *How many staple fibers must be present in order to comprise “a substantial proportion” of all of the fibers constituting the yarn?* The vital and necessary answer to these queries may not be found anywhere within the four corners of the patent.

The great significance of this fact, which fittingly illustrates the necessity for the strict requirement of the statute, is that, concededly, the wool-rayon blankets on the market long prior to the invention of the patent, and in which non-uniform short length fibers were used, *inevitably and necessarily included a very great many fibers of the lengths specified by the Court of Appeals as comprising “staple” fibers.*

It is obvious, therefore, that while, concededly, the public is entitled to the free utilization of *some* fibers of the lengths specified by the patent, some undetermined and undeterminable number of such fibers, at the whim of the



patentee, can be charged to constitute an encroachment on the monopoly purported to have been created by the patent claims. The consequence of this is strikingly illustrated by the fact, previously referred to, that a blanket made from *uniform* short length rayon fibers is indistinguishable from a blanket made from *non-uniform* short length rayon fibers. Indeed, no one, not even respondent's own expert at the trial of the case, on being shown the blanket (Exhibit 7) accused of infringement, could tell whether or not it contained a considerable percentage of "garnetted" rayon (fiber of *non-uniform* short length) mixed in with it (R. 244). In fact, and in order to save the case from dismissal for want of *prima facie* proof of infringement and thereby avoid the publicly important adjudication on validity, it was necessary to stipulate that Exhibit 7 "for the purposes of this case" should be considered as containing 100% "staple" rayon (R. 254-255).

The importance of strict compliance with the requirements of Section 4888 of the Revised Statutes as a protection to the public with respect to patents for *products* was recognized by this Court in *General Electric v. Webash*, 304 U. S. 364. However, it was not until the decision by this Court on November 18, 1946 in *Halliburton Oil Well Cementing Co. v. Walker*, that this Court's attention was centered upon the necessity of compliance with the statutory requirement with respect to patent claims for *combinations* as well. The claims of the Amory patent here involved are for *combinations*, and we believe that no case more effectively illustrates the necessity for the requirement of the statute and the strict compliance therewith than does the present case.

The noncompliance with the statute by the Amory patent was an issue which was most earnestly presented to

the Court of Appeals below (see Point on Appeal No. 9, R. 396) but was rejected by that Court, undoubtedly because of the belief of the inapplicability of this Court's decision in *General Electric v. Wabash* to combination claims.

This Court's decision in the *Halliburton* case was rendered long after the Court of Appeals for the First Circuit rendered its decision in the present case (July 19, 1946) and denied rehearing (October 7, 1946).

In consequence, the decision of the Court of Appeals in this case obviously is untenable in view of this Court's decision in the *Halliburton* case. Therefore, the petition should be granted on this ground.

## POINT V.

**The majority opinion of the Court of Appeals completely ignores the public interest present in this case.**

In *Muncie Gear Works, Inc. v. Outboard, Marine & Mfg. Co.*, 315 U. S. 759 (at p. 768), this Court had occasion to refer to the:

“public interest sought to be safeguarded by the patent statutes and so frequently present but so seldom adequately represented in patent litigation.”

There can be no doubt but that litigation affecting the supply of blankets, thereby affecting the health and comfort of the members of the public, is possessed of an inherent public interest which requires no argument to establish. An unwarranted patent monopoly affecting wool-rayon blankets which afford all members of the public having modest incomes an inexpensive covering with the warmth, strength, durability and appearance of far more expensive

woolen blankets, and on such doubtful grounds as here form the basis for the majority opinion of the Court of Appeals below, should not be permitted without review by this Court.

***Conclusion.***

WHEREFORE petitioner earnestly prays that the petition for writ of certiorari be granted; the case be reviewed; and the judgment of the Court of Appeals for the First Circuit finding validity for claims 7 and 16 of Amory Patent No. 2,208,533 be reversed.

Respectfully submitted,

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October Term, 1935

No. 361

LINCOLN STORE, INC.,  
Petitioner,

v.  
NASHUA MANUFACTURING COMPANY,  
Respondent.

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BRIEF FOR RESPONDENT IN OPPOSITION TO  
PETITION FOR CERTIORARI

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✓ J. L. STACKPOLE,  
H. L. KIRKPATRICK,  
E. H. KENT,

*of Counsel for Respondent.*

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In the  
**Supreme Court of the United States.**

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OCTOBER TERM, 1946.

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No. 768.

LINCOLN STORES, INC.,  
PETITIONER,  
v.  
NASHUA MANUFACTURING COMPANY,  
RESPONDENT.

---

**BRIEF FOR RESPONDENT IN OPPOSITION TO  
PETITION FOR CERTIORARI.**

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**INTRODUCTORY STATEMENT.**

This is an ordinary patent suit on a patent of narrow and definite scope. It involves no conflict of decisions between different Courts of Appeal, but only concurrent findings by the two lower Courts. It raises no new or doubtful question of law and no matter of public importance.

As in *Goodyear Co. v. Ray-O-Vac Co.*, 321 U.S. 275, and *Williams Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, the petition seeks, in effect, a review by this Court of concurrent findings of fact by the District Court (Wyzanski, J.) and of the Court of Appeals (Mahoney, J. and Magruder, J., with Woodbury, J. dissenting) which fully support the findings of validity and infringement by both Courts. In the petition there is no denial of infringement, novelty and utility.

The chief issue presented is that of patentable invention,

the test of which, as stated by this Court in *Sinclair Co. v. Interchemical Corp.*, 325 U.S. 327, 330, is whether the subject-matter displays "more ingenuity . . . than the work of a mechanic skilled in the art". **Both the District Court and the Court of Appeals found this test fulfilled by Amory's invention.**

The history of the art, its struggles and failures and Amory's success, set forth in concurrent findings of both Courts, constitute to a most unusual degree those factors which this Court in *Goodyear v. Ray-O-Vac*, *supra*, held sufficient to determine invention, and amply fulfill all the tests of patentable invention which this Court cited with approval in that case.

Both lower Courts concurred in finding invention both as a matter of law and as a matter of fact. There is no suggestion by the Court of Appeals that it is requesting this Court to decide whether invention is a question of law or one of fact. Nor was the Court of Appeals guided in its decision by a "procedural rule" rather than by the merits of the case in both law and fact.

Findings of fact by both Courts establish that the Amory blanket differed from the prior art not merely in degree but in kind.

Both lower Courts have likewise made concurrent findings of fact that the alleged indefiniteness of the claims, which petitioner asserts as a further basis for review, does not exist.

Petitioner's assertions as to public interest and alleged dominance of this very specific patent over blanket manufacture and the health and welfare of the public are most extravagant and wholly untrue. No matter of public importance is involved.



### THE SIGNIFICANT FACTUAL BACKGROUND OF THE INVENTION.

Petitioner's statement of facts does not accurately reflect the findings of the Courts below as to the nature and factual background of Amory's invention.

The blanket of the patent in suit is a relatively inexpensive blanket which is of greater warmth than any other sort of blanket, including wool blankets, in the same and even somewhat higher price range. Not only that, but it lasts and washes as well as such wool blankets.

Wool blankets had long been the standard of excellence for the reason that the wool fibers make up into a high, lofty, homogeneous nap on each side of the blanket, which nap is full of myriads of small air spaces affording the best possible heat insulation, *i.e.*, they prevent the transfer of heat through the blanket.

For years prior to Amory's invention, skilled workers in the art had been endeavoring to make a blanket essentially of rayon fiber which would have a warmth and lasting qualities comparable to a wool blanket but would be less expensive because of the relatively low cost of rayon. But their efforts had been failures. The rayon blankets they produced lacked the characteristic lofty, uniform, homogeneous nap of wool blankets, which gives them their warmth, and the naps of their blankets shed excessively.

The difficulty of producing a blanket with a nap, substantially of rayon, having these characteristics of a nap of wool, had proved insurmountable to all others before Amory because of the radical antithetic difference between wool and rayon. Wool is curly, springy and covered with rough overlapping scales. These characteristics cause the wool fibers, when napped as in blanket making, to intertangle and support each other to form a lofty homogeneous substantially non-shedding nap containing the myriads of air spaces which inhibit the transfer of heat. Rayon is the

opposite. It is smooth, straight and stiff, like a fine glass thread.

These radical differences, coupled with the failure of all attempts to produce a rayon blanket comparable to a wool blanket, had led skilled workers in the art to believe that such a result was impossible.

The Court of Appeals found:

“Blankets made essentially of rayon had been known for many years but until the Purrey blanket was placed on the market no rayon blanket achieved any great degree of commercial success. This was due to the fact that the nap of the rayon blankets prior to Amory was not lofty or uniform and shed easily. Men skilled in the art attributed this to the unelastic, straight, smooth qualities of rayon, and thus they believed that rayon could not be used to produce a blanket similar in quality to a wool blanket. Wool, however, is elastic, curly and rough.” Tr. p. 408.

“The attainment of the result reached by Amory required more than merely substituting rayon fibers for the wool fibers used by Neaves. The qualities of the two materials are vastly different. What would have resulted from a mere haphazard substitution is highly speculative. For years, men skilled in the art had endeavored to substitute rayon for wool in the manufacture of blankets with little success. That made it amply clear that such a substitution would not achieve the desired result without knowledge of the particular type of rayon fiber needed. Amory was the first to disclose that the fibers must be of relatively coarse denier and that they should be cut to a specific predetermined length. Without the disclosures made by Amory, we cannot say that a substitution would have been successful.” Tr. p. 411.

"Amory's patent was the first to teach that a blanket constituted chiefly of rayon fibers would be successful only if the fibers were of a specified length and denier, undrafted and loosely wound around the hard-twisted core." Tr. p. 412.

"Amory's combination produced a new result, although it may have been composed solely of known ingredients, and there is evidence that this result was not expected by the art. Amory's blanket was eagerly received by the consuming public. The Amory patent meets all the tests set forth by the cited cases." Tr. p. 417.

These essential holdings of the Court of Appeals confirm the findings of the District Court. Tr. pp. 31, 32, 35-39.

Among the many attempts and failures which preceded Amory's invention were those of the expert blanket makers of Marshall Field & Co., the real defendant and petitioner in the case. These began in 1927.

The Court of Appeals found that:—

"As late as 1938 Marshall Field did not know Amory's secret." Tr. p. 414.

Finally in 1940, after thirteen years of effort and failure, Marshall Field made its first successful rayon blanket by copying the Purrey blanket of the Amory patent.

Both courts below found that none of these prior unsuccessful blankets nor any of the numerous patents and publications relied on by petitioner discloses or even suggests the Amory invention (Tr. pp. 410-415; 35-38).

It is with this background of facts, found by the District Court and affirmed by the Court of Appeals—the long felt want, the apparently insurmountable difficulties of the problem, the struggles and failures of the prior art, the success first achieved by Amory, the immediate imitation

and wanton infringement by Marshall Field—that petitioner's five points are to be evaluated.

#### PETITIONER'S FIRST AND SECOND POINTS ARE FICTITIOUS.

Petitioner's first and second points are without substance. No one, either counsel or Court, has heretofore based an argument either for or against patentable invention in this case on whether or not the question of patentable invention was one of law or one of fact. It is a fictitious unsubstantial issue here because in either case such invention is present and it was so held both by the District Court and by the Court of Appeals.

This alleged procedural issue is mere pretext by which petitioner seeks to cloak its effort to obtain an unwarranted review of the concurring decisions on the merits. Petitioner does not ask that the Court of Appeals be directed to reconsider invention as a matter of law, the appropriate remedy if that Court had really considered itself "foreclosed" and "precluded" from applying the law by erroneously regarding the District Court finding of invention as one of fact (petition, pp. 5, 11, 13-14). Instead, petitioner, being well aware that the Court of Appeals found invention both in fact and in law, asks this Court to review and reverse that finding on the merits (petition, pp. 8, 21).

Fundamentally the test of invention is that stated by this Court in *Sinclair Co. v. Interchemical Corp.*, *supra*, p. 2.

The Court of Appeals repeatedly points out that the facts show invention by that test, according to established principles of law (Tr. pp. 412-417):—

"Without the disclosures made by Amory, we cannot say that a substitution [rayon for wool] would have been successful. Nor can we say that the substitution specified by Amory was apparent to a man skilled in the art. The many years of futile research and labor by men skilled in the art is weighty evidence of this.

*Williams Iron Works Co. v. Hughes Tool Co.*, 109 F. (2d) 500, 510 (C.C.A. 10, 1940)."

. . . . .

"Staple rayon had been known and was available, at least for research purposes, many years before Amory applied for his patent. And yet no one had thought to use it in the combination or process evolved by Amory. This is certainly evidence of invention. *Dewey & Almy Chemical Co. v. Mimex, supra*, at 987."

. . . . .

"The fact that these elements were known for some time prior to Amory and that the successful combination remained undiscovered before Amory's patent is entitled to considerable weight. Rayon staple was known for many years before Amory, but the art had taught that the most beneficial use of these fibers would be derived by spinning them into a thread rather than leaving them undrafted and randomly intermingled. The previous adoption of an essential element of a patent for another and distinct purpose does not constitute anticipation. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 58 (1923)."

. . . . .

"But, here, there is, at least doubt on the question of invention. In such a case, it is elementary that the existence of the problem for many years, without solution in spite of prolonged efforts by numerous experts, and the rapid public acceptance of the proffered solution, are entitled to consideration as weighty evidence of invention. *Hughes Tool Co. v. International Supply Co.*, 47 F. (2d) 490, 492 (C.C.A. 10, 1931)."

. . . . .

"But the fact that a new combination of old elements produces a new and beneficial result, hitherto un-

attained, merits consideration as evidence of invention. *Loom Co. v. Higgins*, 105 U.S. 580, 591 (1881)."

"And a substitution which involves a new mode of construction, or develops new uses and properties of the article formed, may amount to invention. *Smith v. Goodyear Dental Vulcanite Co.*, *supra*, at 492, distinguishing *Hotchkiss v. Greenwood*, 11 How. 248."

"A patentable combination may be comprised of elements that are all old or all new, or partly old and partly new. *Leeds & Catlin Co. v. Victor Talking Machine Co.*, (No. 2) 213 U.S. 325, 332 (1909)."

"Where none of the patents in the prior art disclose all the elements of the patent in issue, they cannot be combined for that purpose, *Cover v. Chicago Eye Shield Co.*, 111 F. (2d) 854, 859 (C.C.A. 7th, 1940)."

"An inventor cannot be denied the rights derived from a patent merely because he has combined elements, all of which were known to the prior art, if he has produced something involving novelty and utility. *National Aluminate Corp. v. Permutit Co.*, 145 F. (2d) 175, 179 (C.C.A. 8, 1944); *Monarch Marking System Co. v. Dennison Mfg. Co.*, 92 F. (2d) 90, 94 (C.C.A. 6, 1937)."

"A finding of invention may be warranted where the patentee combines features, even though all of them are known to the prior art, which produce a new result, especially where that combination enjoys marked commercial success. *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279 (1944); *Halliburton Oil*

*Well Cementing Co. v. Walker*, 146 F. (2d) 817, 819 (C.C.A. 9, 1944); *Texas Rubber & Specialty Corp. v. D. & M. Machine Works*, 81 F. (2d) 206, 208 (C.C.A. 5, 1936)."

"That on retrospect the device appears simple or obvious does not necessarily establish a lack of invention. *Loom Co. v. Higgins*, *supra*, at 591."

"It is indeed significant in this respect that the workers in the art had labored long and extensively to produce the blanket first produced by Amory. *Potts v. Creager*, 155 U.S. 597, 608 (1895)."

"Retrospection is often deceptive and cannot be accorded recognition in the law pertaining to patents. *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 435 (1911)."

"At least Amory provided the final step that proved the difference between success and failure. This is a factor which has been accorded considerable recognition in the courts. *The Barbed Wire Patent*, 143 U.S. 275, 283 (1892); *Consolidated Safety-Valve Co. v. Crosby Steam Gauge & Valve Co.*, 113 U.S. 157, 179 (1885)."

The foregoing are established rules of law applicable to the judicial determination of the question of patentable invention.

The Court of Appeals found Amory's invention to be patentable as a matter of law saying, Tr. p. 417:—

"The Amory patent meets all the tests set forth by the cited cases."

The Court, in order to leave no doubt as to the thoroughness of its decision, also found that, if the question was viewed as one of fact, the same conclusion must be reached:

“The presumption of the validity of Amory’s patent arising from its issuance, *Mumm v. Decker & Sons*, 301 U.S.168, 171 (1937), taken together with the many years of effort to produce what Amory produced and its substantial commercial success, makes it impossible for us to say that the district court was clearly erroneous in deciding that Amory had produced a patentable invention. Rule 52a, F.R.C.P.” Tr. p. 418.

The Court of Appeals thus held, both as a matter of law and as a matter of fact, that Amory had made a patentable invention. The Court found it “impossible” to differ from the District Court finding of invention because Amory’s accomplishment satisfied all the legal tests of invention, not because of “the exacting requirement of Rule 52(a)” as the petition contends (p. 4).

The foregoing is a complete answer to the petitioner’s contention that the opinion of the Court of Appeals is virtually a request that this Court determine in this case whether the question of patentable invention is one of law or one of fact. That there is no such request, the opinion speaks for itself.

Moreover, petitioner’s argument is unsubstantial because the Court of Appeals had the right, if it so wished, to certify such a question to this Court. That it did not do so leaves no doubt but that a decision of such question was not material to its decision.

Petitioner’s assertion that the decision of the Court of Appeals was based on “procedural grounds” is wholly unfounded. The Court’s affirmance of the finding of invention as one of “fact” was but the confirmation of its hold-



ing that the patent satisfies all the tests of invention according to settled rules of law.

There is no statement or even a hint or suggestion that its decision turned on the point whether patentable invention is a question of law or of fact, and the opinion affirmatively shows the contrary, as above pointed out.

### PETITIONER'S THIRD POINT IS UNSOUND.

Petitioner's third point, that the advance in the art made by Amory was one of degree, not of kind, and hence unpatentable, is unsound.

The advance in the art made by Amory was the production of a blanket made substantially of rayon which had a nap having the qualities of a wool nap.

Here was a new result, a change in kind not merely one of degree. Both the District Court and the Court of Appeals so found and held.

The Court of Appeals found:—

“But these publications do not teach the lesson which the art awaited. They only teach the existence of the materials utilized by Amory. They do not disclose, as did Amory, that when rayon fibers are used in a blanket construction they must be 1" – 2" in length and of a denier of at least 4.00 and kept in a randomly intermingled state, loosely wound around a core thread. Amory's precise combination was unknown to the art, although, perhaps, all of its elements had been previously disclosed and utilized. There is no indication from the prior publications or patents that the combination of elements used by Amory would produce a nap having the lofty, uniform and warmth-giving characteristics of the Purrey blanket.” Tr. p. 413.

“It was not until Amory used staple rayon of specified length and denier that the result toward which the

efforts of the art had been directed was obtained.” Tr. p. 414.

“Amory’s combination produced a new result, although it may have been composed of known ingredients, and there is evidence that this result was not expected by the art.” Tr. p. 417.

These holdings by the Court of Appeals confirm the findings of the District Court. Tr. pp. 35–40.

On such a matter of fact there was no conflict between the findings of the Courts. This Court has ruled that it will not disturb such concurrent findings of the lower Courts.

*Goodyear Co. v. Ray-O-Vac Co.*, 321 U.S. 275.

*Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, 367.

Judge Woodbury in his dissenting opinion stated that “the distinction [between differences in degree and differences in kind] is unsatisfactory in that each case must be decided on its own facts as it arises and in close cases like the present differences of opinion are normally to be expected”. He differed from both the District Court and the majority of the Court of Appeals only on this question of fact.

The majority specifically held that the decision in *Hotchkiss v. Greenwood*, 11 How. 248, relied on by the dissenting judge and by petitioner, was inapplicable and that the case was governed instead by *Smith v. Goodyear*, 93 U.S. 486, saying:

“A substitution which involves a new mode of construction, or develops new uses and properties of the article formed, may amount to invention. *Smith v. Goodyear Dental Vulcanite Co.*, *supra*, at 492, distinguishing *Hotchkiss v. Greenwood*, 11 How. 248 . . .

The Amory patent meets all the tests set forth by the cited cases." (Tr. pp. 416-417.)

There is no "rule of law" that a substitution of one material for another is not patentable invention.

To the contrary are such authorities as—

*Smith v. Goodyear*, 93 U.S. 486, 495.

*Potts v. Creager*, 155 U.S. 597, 608, 609.

In *Celluloid Mfg. Co. v. Frederick Crane Chemical Co.*, 36 Fed. Rep. 110, Justice Bradley, sitting with the Circuit Court of New Jersey, said, p. 112:—

"There is no rule of law that the substitution of one material for another is not patentable. In processes of manufacture, and in compositions of matter, such a substitution often effects material changes in the result, either as to the product or the expense."

In *Remington Rand v. Acme Co.*, 71 F. (2d) 628 (C.C.A. 4th) the Court said p. 632:—

"There is, however, no rule of law that the substitution of a new material for an old is not patentable. The question is always whether the alteration requires invention or merely the exercise of mechanical skill and judgment. The answer must be found in the light of the circumstances of the particular case."

#### PETITIONER'S FOURTH POINT IS UNSOUND.

There is nothing indefinite or vague about the claims sustained by the Court of Appeals. Both Courts concurred in finding that the alleged indefiniteness of the claims which petitioner asserts as its fourth point does not exist in fact.

The opinion of the Court of Appeals states:—

"The defendant challenges claim 7 of the Amory patent as not meeting the standards of clarity required by R. S. 4888 because it is impossible to determine

whether a given blanket infringes the patent. This challenge is based on the defendant's assertion that the word 'staple' as used in the claim has no exact meaning. The defendant asserts that the word 'staple' is used merely to distinguish short filaments from long filaments; that staple rayon is made by cutting long filaments into relatively short lengths or fibers, ordinarily of uniform length; that staple fibers are found in both the uniformly cut fibers and in garnetted material. The district court held, however, that the word 'staple' as commonly used in the rayon industry and as used in this patent, means a filament cut to a predetermined length and that this definition read in the light of the specifications requires that the filling wrapping contain fibers of a predetermined length, preferably 1" to 2", and it concluded that there was no difficulty in deciding which blankets infringe and which do not. We agree with the district court."

Such concurrent findings of the two lower Courts are accepted by this Court (*supra*, p. 12).

In Amory's claims there is no all-inclusive language at the point of novelty, which extends them beyond his limited invention, as in the recent case of *Halliburton Oil Well Cementing Co. v. Walker*. The decision of this Court in that case, on which petitioner relies, is not relevant.

#### PETITIONER'S FIFTH POINT IS UNSOUND.

The Court of Appeals, in sustaining the claims of the Amory patent, did not in the least ignore the public interest. Its decision did not involve a matter of public importance beyond the usual public interest in all patent cases which the Court carefully guarded by a most thoroughgoing review of the facts and pertinent authorities.

The Amory patent, as to the claims sustained, is a narrow patent on a blanket composed in a particular way of a specified kind of rayon staple.

As the invention has proved commercially successful Marshall Field would like to copy it, but this is no ground for asserting that a matter of public interest or importance is involved in this case.

Marshall Field and all other blanket manufacturers can make other sorts of blankets, cotton blankets, wool blankets and blankets made with rayon of different deniers and different lengths than those covered by the patent.

The patent is limited to the particular blanket structure which was new with Amory and takes nothing from the public.

#### CONCLUSION.

For the foregoing reasons the Petition is without merit and should be denied.

Respectfully submitted,

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H. L. KIRKPATRICK,  
E. H. KENT,

*Of Counsel for Respondent.*